

## **AMENDMENTS TO DRAWINGS**

The attached sheet of drawings includes changes to Fig. 2B, 4, 11, 13, and 14. The sheets, which include Fig. 1-15, replace the original sheet including Fig. 1-15. In Figure 2B, previously omitted element 202 has been added. In Figure 4, previously omitted element 401 has been added. In Figure 11, previously omitted element 1104 has been added. In Figure 13, Applicant has changed the element referenced by 223 to be referenced by 213. In Figure 14, Applicant has changed the element referenced by 401 to be references by 1401.

Attachments: Replacement Sheet

Annotated Sheet Showing Changes

## REMARKS/ARGUMENTS

### Reference Correction

In a telephone conversation between Examiner Daniel Stephenson and Rachael Stiegel (54,469) on 3 January 2006, Examiner Stephenson confirmed that an error was made in the original Office Action. Any reference to WIPO document WO 03/0006788 to Lohbeck should be replaced with a reference to WIPO document WO 02/291199 to Cook.

### Drawings

In Paragraphs 1 and 2 of the Office Action, Examiner objects to the drawings for failing to include a reference to element 401 and for typographical mistakes in Figures 13 and 14. Applicant has amended the drawings in accordance with Examiner's suggestions. In Figure 4, previously omitted element 401 has been added. In Figure 13, Applicant has changed the element referenced by 223 to be referenced by 213. In Figure 14, Applicant has changed the element referenced by 401 to be referenced by 1401.

In addition, Applicant has made other amendments to the drawings based on typographical errors. In Figure 2B, previously omitted element 202 has been added. In Figure 11, previously omitted element 1104 has been added. All amendments to the drawings are supported by the specification. Applicant respectfully requests that the objection to the drawings be withdrawn.

### Specification

In Paragraph 3 of the Office Action, Examiner objects to the specification due to informalities. Applicant has amended the specification on page 15 line 18 by replacing reference numeral 219 with 223 and replacing reference numeral 217 with 221. Applicant respectfully requests that the objection to the specification be withdrawn.

In Paragraphs 4 and 5 of the Office Action, Examiner objects to the Abstract because it is one long sentence and is greater than 150 words. Applicant has provided a replacement abstract that is less than 150 words. Applicant respectfully requests that the objection to the Abstract be withdrawn.

### Claim Objections

In Paragraph 6 of the Office Action, Examiner objects the claims due to misnumbering and has renumbered claims 3-10. Applicant has renumbered the claims to reflect Examiner's suggestion. Applicant respectfully requests that the objection to the claims be withdrawn.

### Claim Rejections Under 35 U.S.C. §102

In Paragraphs 7 and 8, Examiner rejects claims 1-3, 9, and 10 under 35 U.S.C. §102(b) as anticipated by WIPO document WO 02/291199 to Cook (hereafter Cook). Applicant respectfully disagrees because Cook does not disclose each and every element of the claimed invention.

With respect to claim 1, Cook does not disclose converting the expandable mandrel to a first expansion diameter *while the expandable mandrel is within the casing*. Examiner asserts that converting should be read broadly as preparing the mandrel in a first diameter. Even if one were to use this broad interpretation of the term, the mandrel in Cook is not converted *after* it is placed within the wellbore while it is *within the casing*. The preparation of the mandrel is completed at the surface prior to installations in the well. Cook does not disclose each and every element of claim 1; therefore claim 1 is not anticipated by the reference. Claims 2, 3, 9, and 10 depend from allowable claim 1 and merely add additional elements thereto. Therefore Applicant respectfully requests that the rejection of claims 1-3, 9, and 10 under 35 U.S.C. §102(b) be withdrawn and the claims formally allowed at this time.

Claim Rejections under 35 U.S.C. §103

In Paragraphs 9-10, Examiner rejects claims 4-6 under 35 U.S.C. §103(a) as being unpatentable over Cook in view of pre-grant publication US20050056433 to Ring (hereafter Ring). In Paragraph 11, Examiner rejects claims 7-8 under 35 U.S.C. §103(a) as being unpatentable over Cook in view of Ring as applied to claim 5 and further in view of pre-grant publication US2002/0033262 to Musselwhite. Examiner has failed to establish a *prima facie* basis for rejection of these claims.

MPEP §2143.03 states:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

As argued earlier, Applicant respectfully submits that the references do not disclose converting the expandable mandrel to a first expansion diameter while the expandable mandrel is within the casing as claimed in claim 1. Claims 4-6 and 7-8 depend from allowable claim 1. Because all of the claim limitations are not taught or suggested by the prior art, Examiner has failed a *prima facie* case of obviousness. Applicant respectfully requests that the rejection of claims 4-6 and 7-8 under 35 U.S.C. §103(a) be withdrawn and the claims formally allowed at this time.

Allowable Subject Matter

Examiner has indicated that claims 11 and 12 are objected to for being dependent on a rejected base claim, but would be allowable if rewritten in dependent form. Applicant thanks Examiner for indicating the allowability of these claims.

Conclusion

Applicant has addressed each and every objection and ground for rejection. The amended claims are patentable over the cited art and Applicant requests that the application be allowed. In the event the Examiner has any questions or there are any issues with respect to the application, the Examiner is invited to call the undersigned at the telephone number below prior to the issuance of any written action.

Respectfully submitted,

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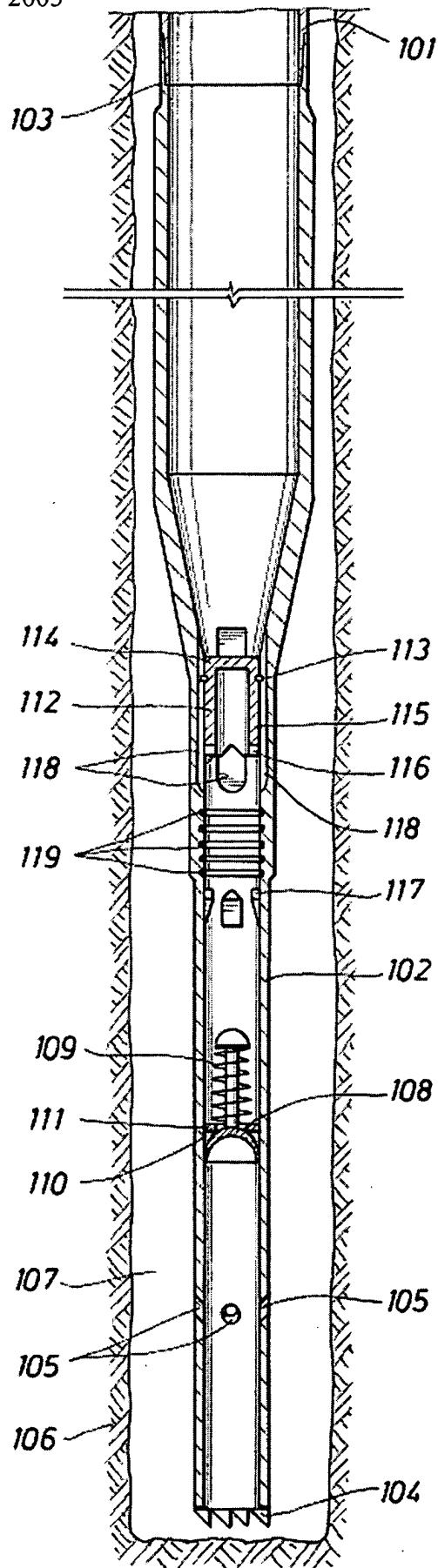


FIG. 1

FIG. 2A

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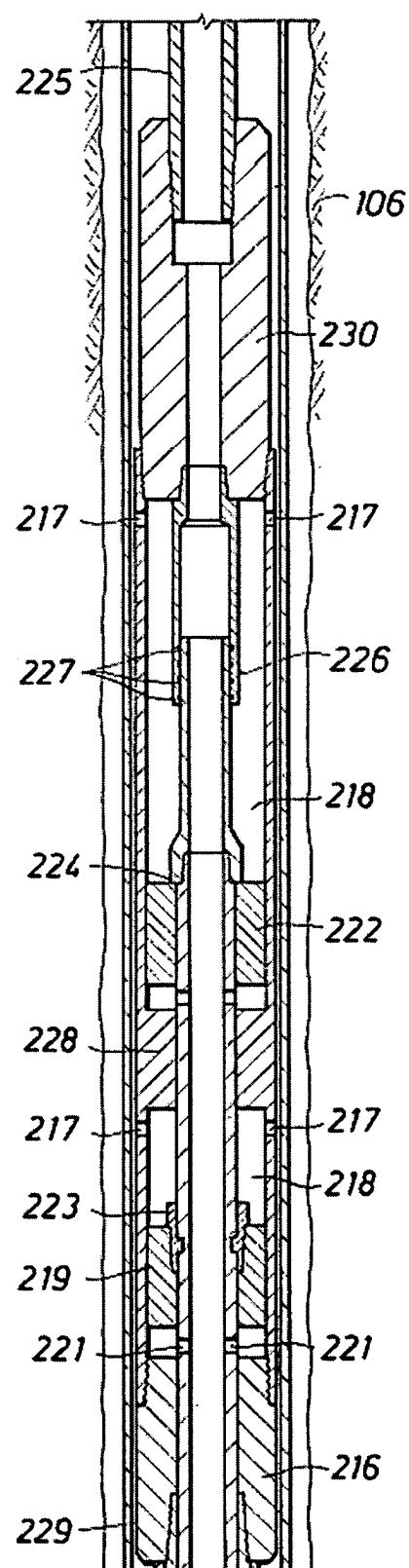


FIG. 2B

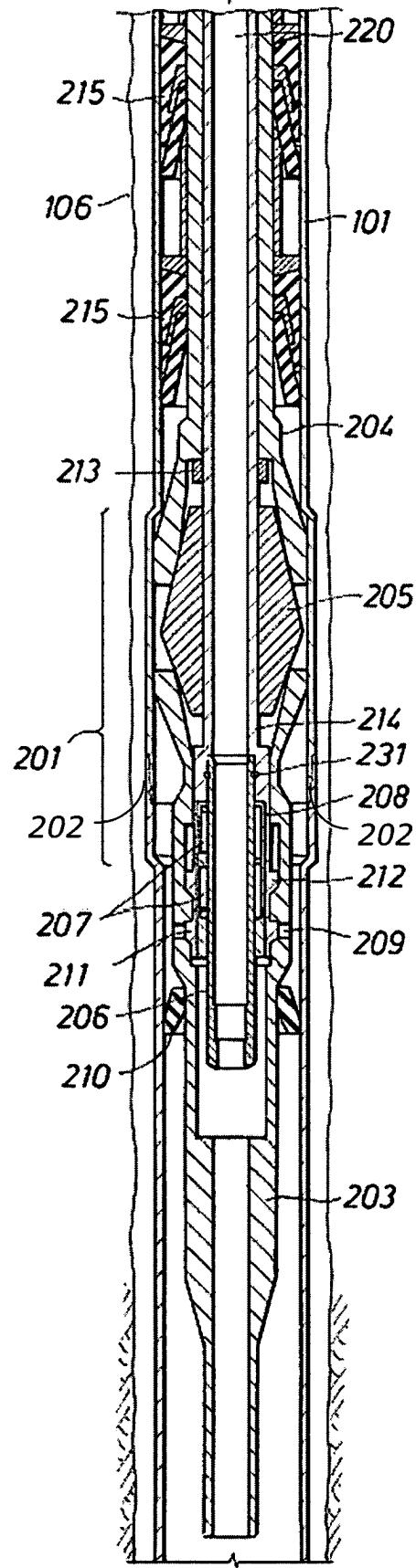
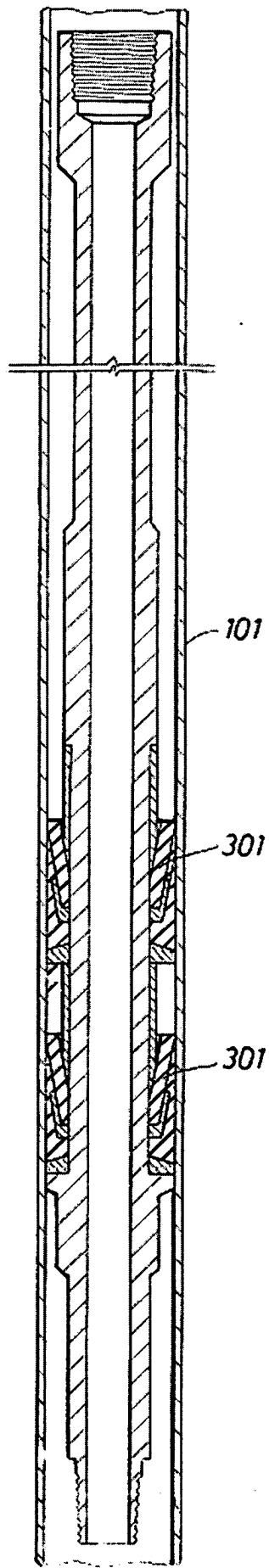


FIG. 3



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FIG. 4

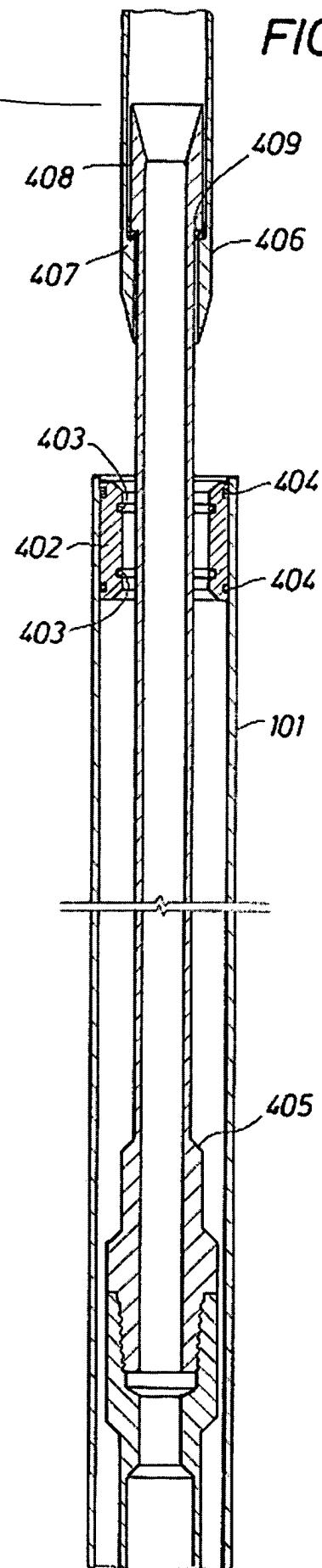
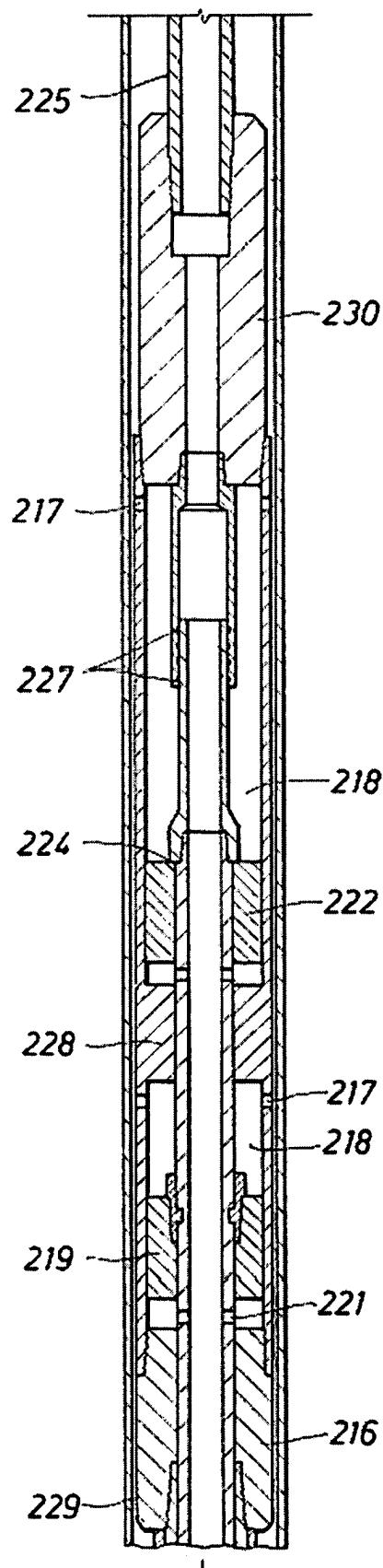


FIG. 5A



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FIG. 5B

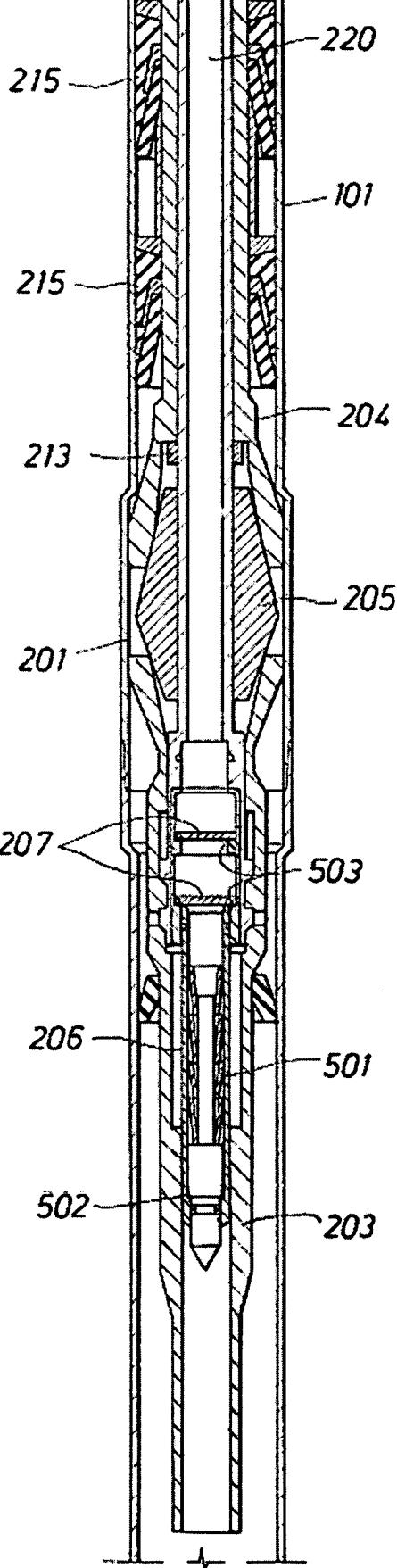
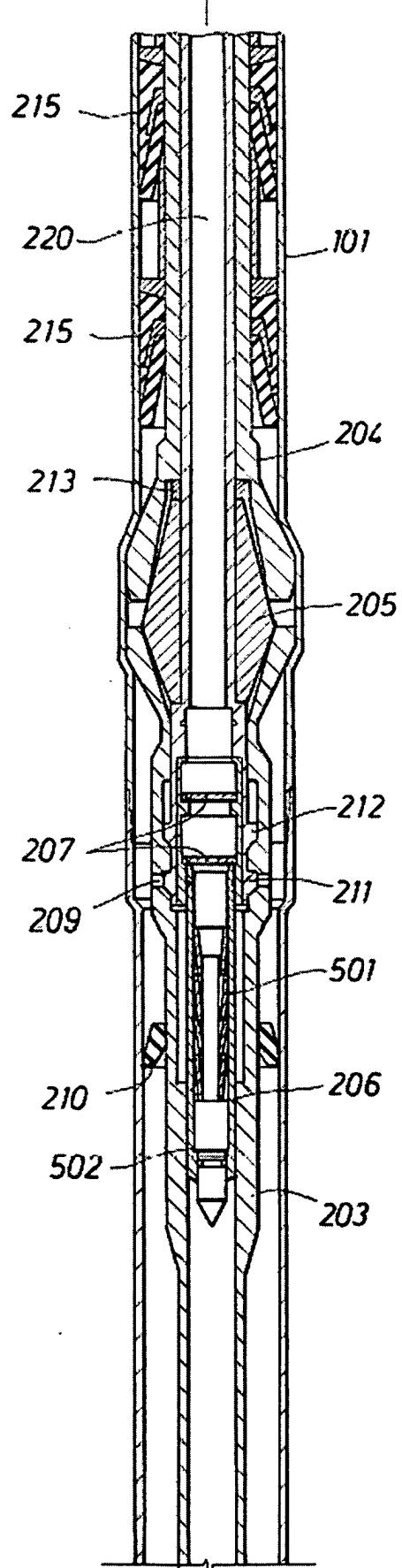
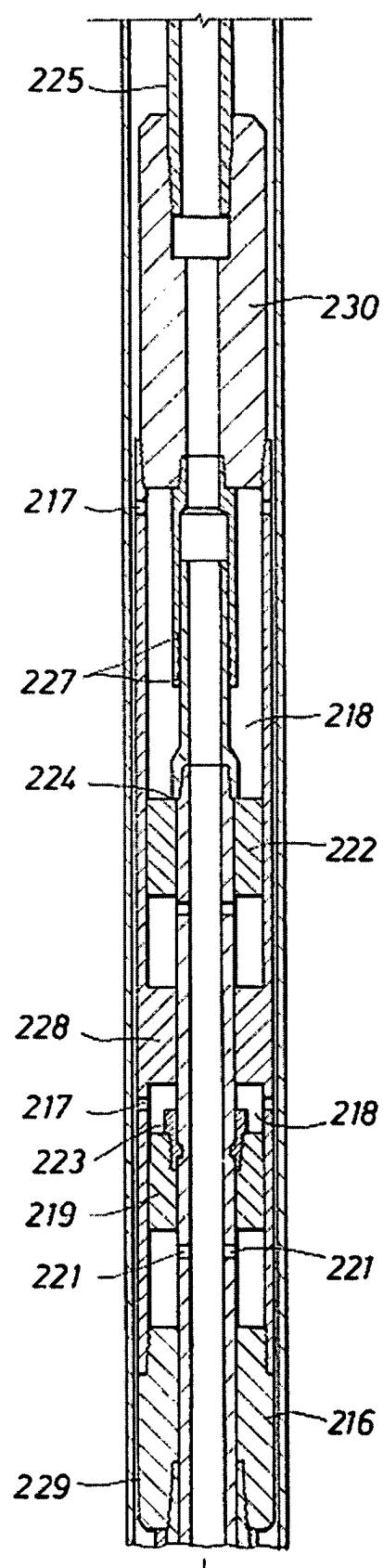


FIG. 6A

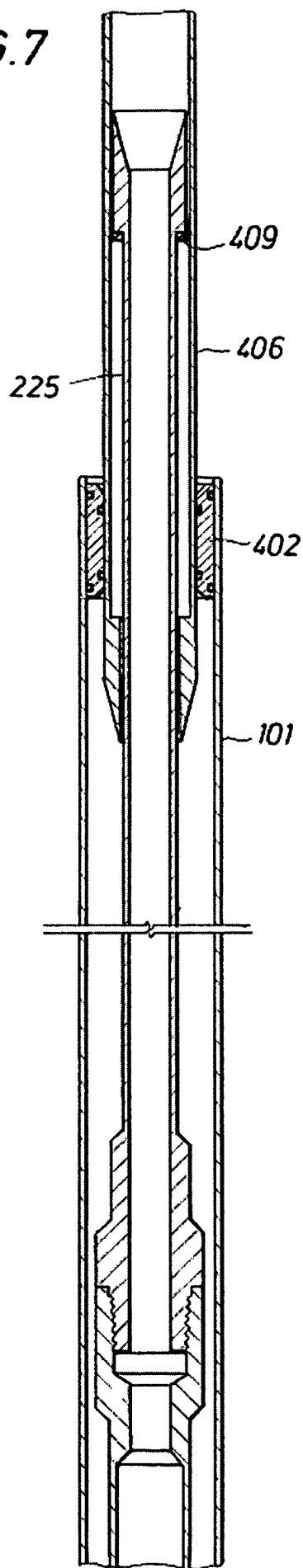
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FIG. 6B



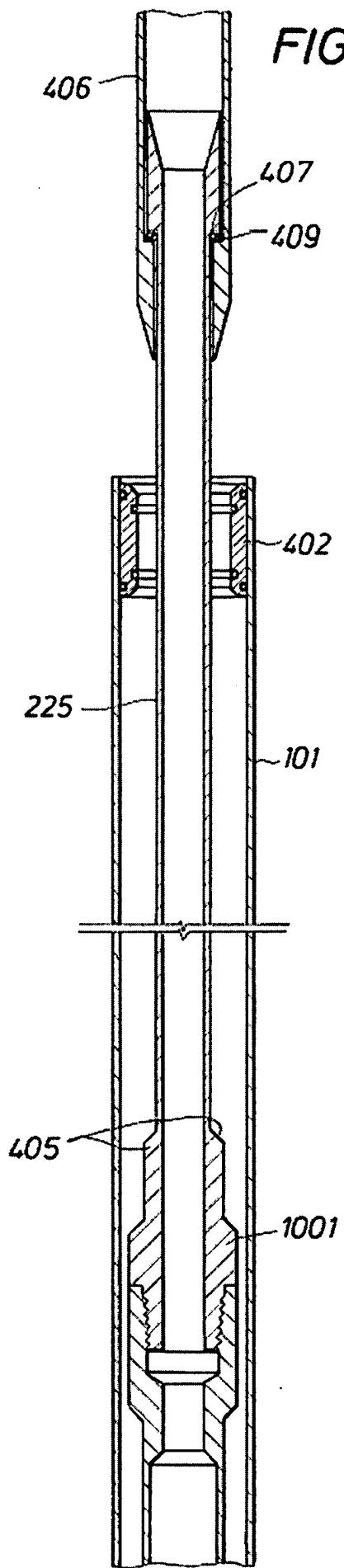
Annotated Sheet

FIG.7



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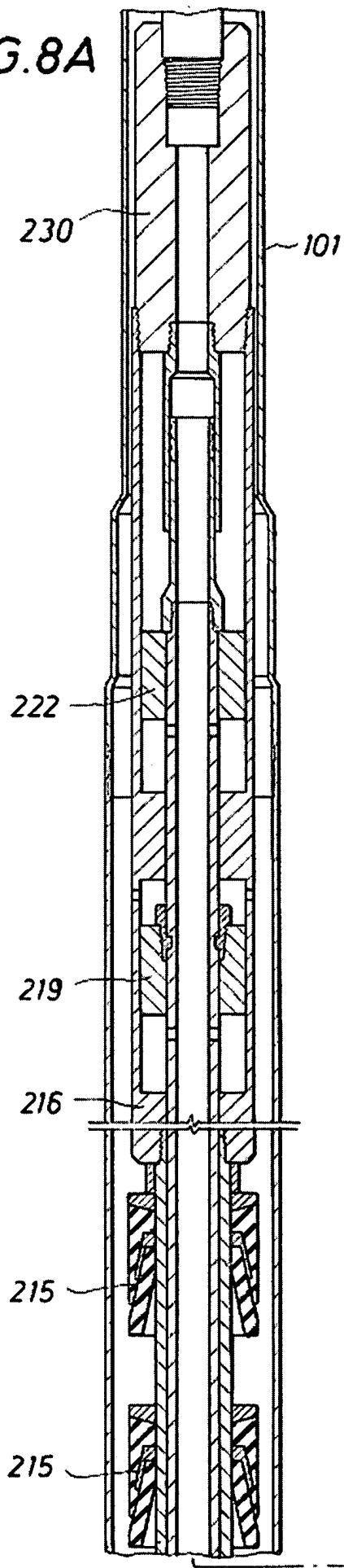
FIG.10



Annotated Sheet

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FIG.8A



103 205

112 108

119

FIG.8B

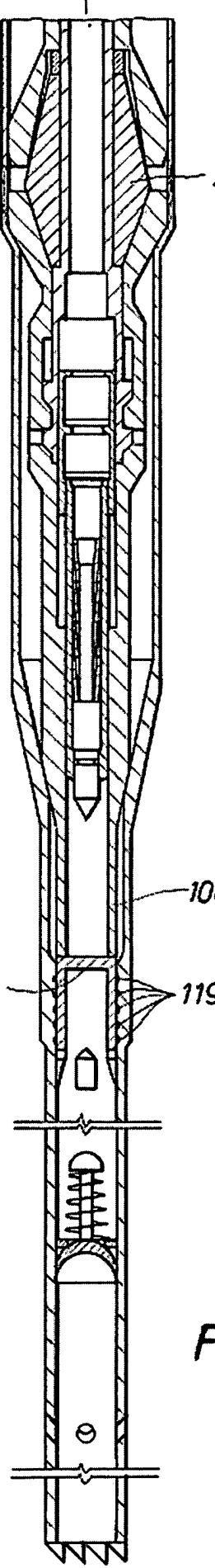


FIG.9A

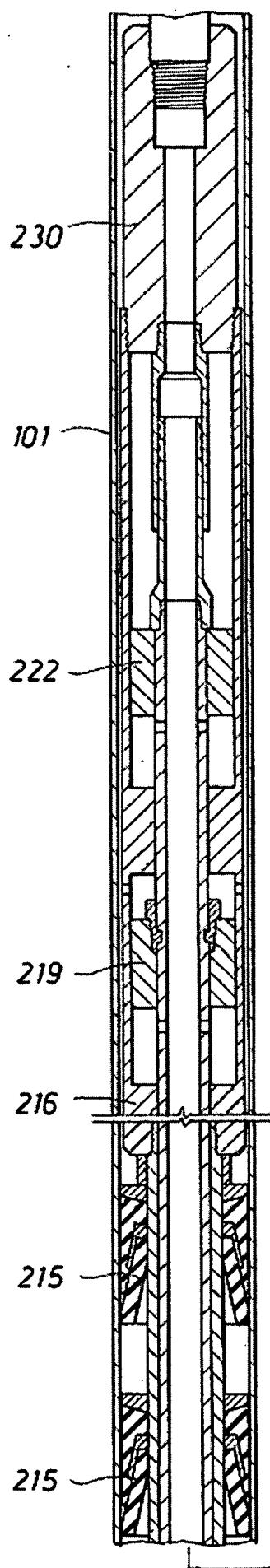


FIG.9B

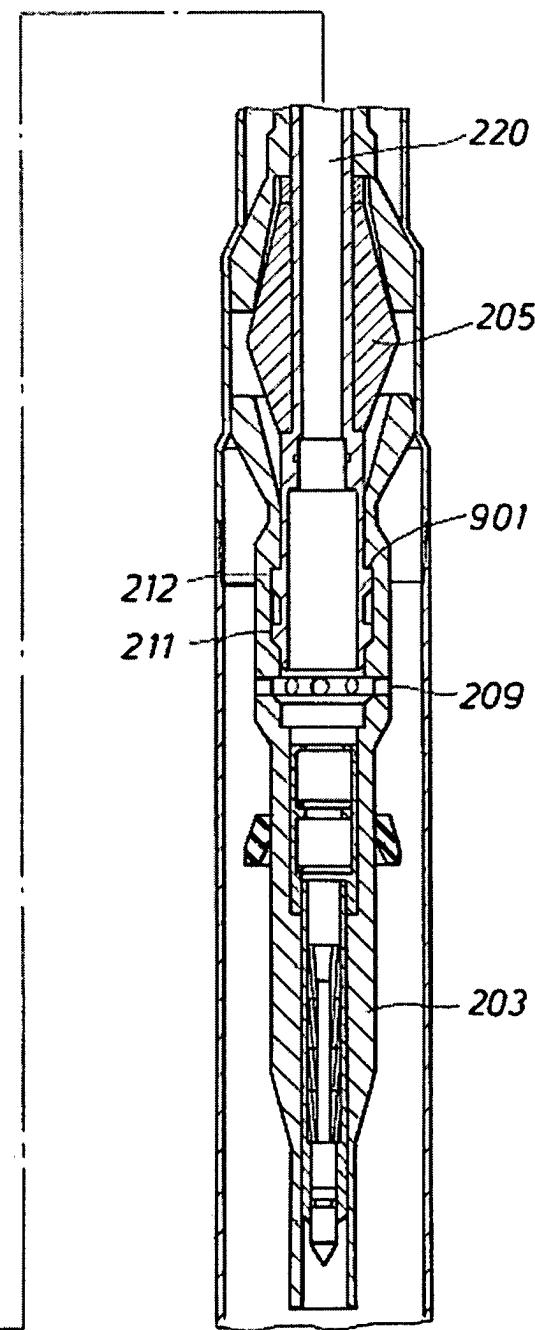


FIG.11

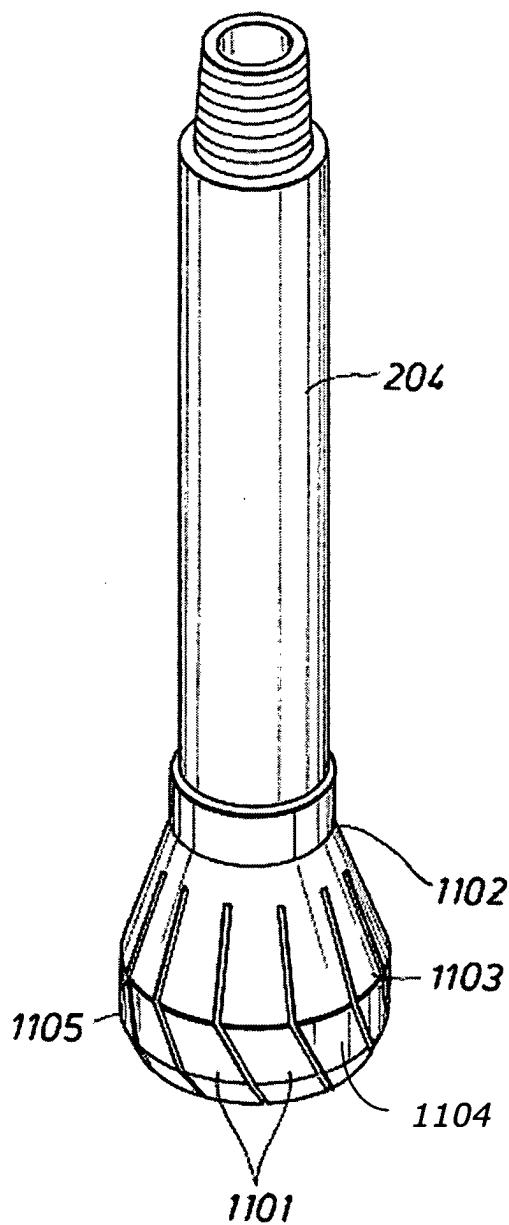


FIG.12

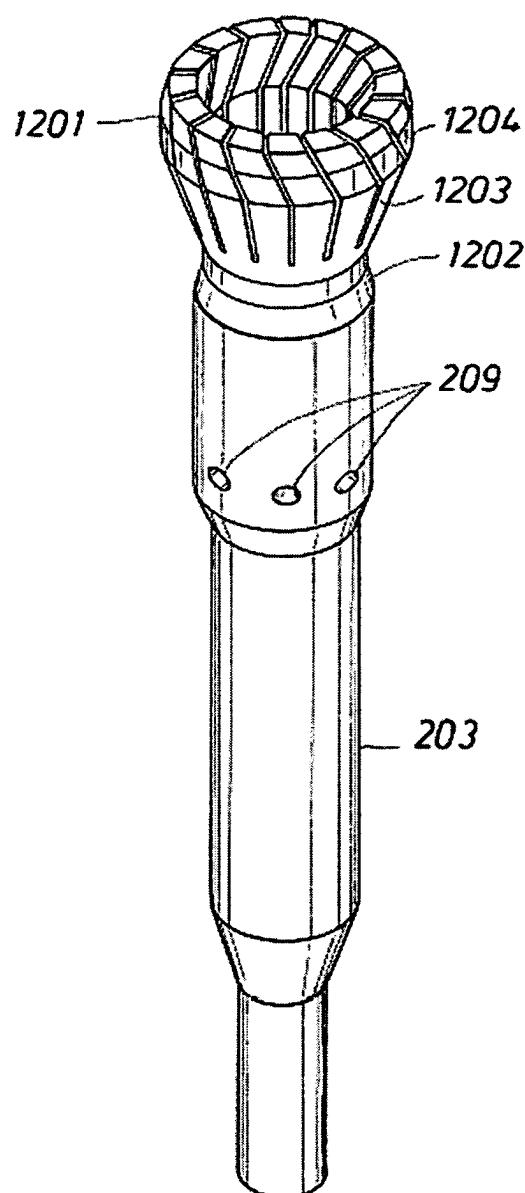


FIG.13

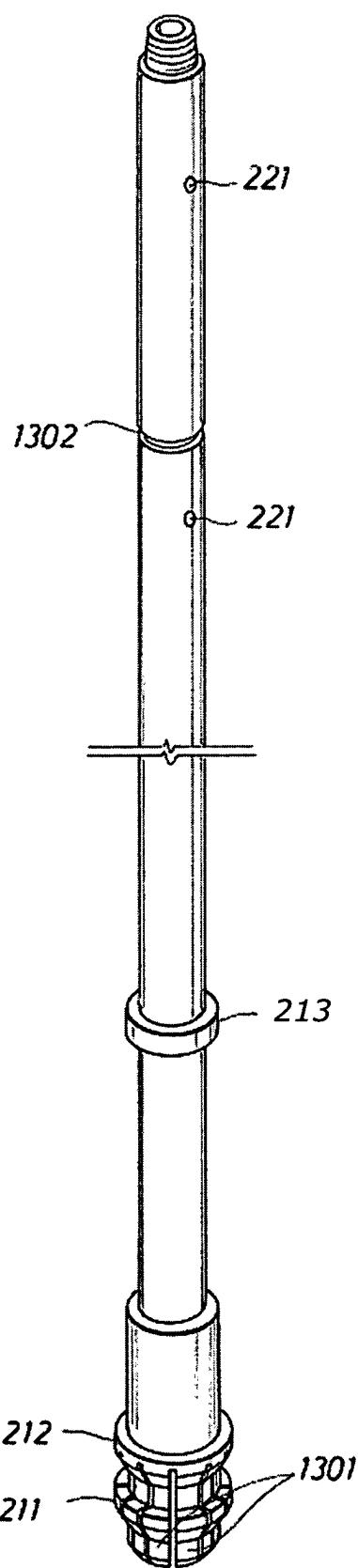


FIG.14

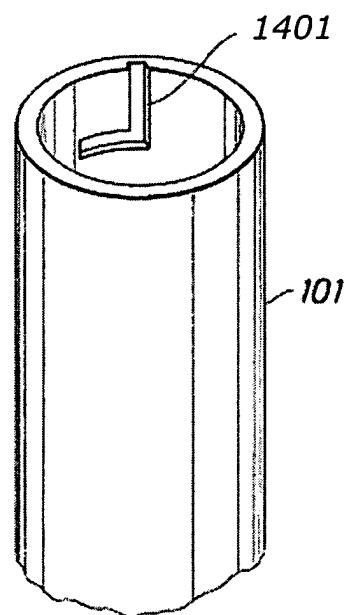


FIG.15

